

REMARKS

The applicants note that the elected species have been determined to be free of the prior art, but the claims are objected to as containing non-elected subject matter and would be allowable if rewritten in independent form including all of the limitations of the elected species and “closely related subject matter.”

While the applicants appreciate the indication that the elected species is free of the prior art, they are left without guidance with respect to what “closely related subject matter” may entail.

But, moreover, it appears that a search and examination of the full scope of the claims as required by MPEP 803.02 has not been conducted. MPEP 803.02 states,

In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. An examiner should set forth a requirement for election of a single disclosed species in a Markush-type claim Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.

* * *

[S]hould the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. . . . The examination will be extended to the extent necessary to determine patentability of the Markush-type claim.

(Emphasis added.) These Patent Office guidelines expressly require the examiner to continue to expand the search “to the extent necessary to determine patentability of the Markush-type claim,” which means until the full scope of the claim has been searched or prior art is found that is alleged to render the claim unpatentable.

The applicants respectfully submit that these Guidelines have not been followed. The search has been suspended without (a) any indication of why the search was not expanded further or, more significantly, (b) without any prior art being identified as justifying suspending further expansion of the search.

In view of the foregoing, the applicants submit that the search and examination must be extended to the full extent permitted by the prior art, up to the full scope of the claims, as required by MPEP 803.02.

If there are any questions or comments regarding this paper or the application, the Examiner is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

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